

REMARKS

Applicants have cancelled Claims 1-8. New Claims 9-28 are added. No new matter has been incorporated by these amendments.

In accordance with the Office action dated March 12, 2008, Applicants elect Figure 2C with traverse. Currently Claims 9-13, 16-28 read on Figure 2C.

With respect to the election of species, it is submitted that the individual figures must be considered as a whole because Figures 1-10 are directed to the same modular closet system. The compounds must be considered "as a whole" and not broken down to their individual portions. *In re Jones*, 162 F.2d 479, 746 USPQ 149 (CCPA 1947). The fact that there might be subgeneric structures encompassed by a claimed generic structure does not allow the Examiner to divide the generic claim up into subgeneric claims. To do so, would prevent Applicants from claiming their invention as they see fit.

The Examiner's restriction is improper as inconsistent with the requirements set forth in *In re Haas*, 580 F.2d 461, 198 USPQ 334 (CCPA 1978); *In re Weber*, 580 F.2d 455, 198 USPQ 328 (CCPA 1980) and *In re Harnisch*, 631 F.2d 716, 206 USPQ 300 (CCPA 1980). The Markush groups of the claims do not embrace plural, separate and distinct inventions.

In *Weber*, the invention is directed to cyclic diamine derivative identified by a single generic formula expressed in Markush format and to which a common psychotherapeutic property is attributed. The Examiner rejected claim 1 as embracing 24 enumerated independent and distinct inventions and rejected claims 1-6 as being improper Markush claims. The court reversed and remanded the case for reconsideration of the "improper Markush" rejection. The court stated:

“...An applicant is given, by the statute, the right to claim his invention with the limitations he regards as necessary to circumscribe that invention, with the proviso that the application comply with the requirements of 35 U.S.C. §112...”

Judge Rich stated in his concurrence that:

“The practice here challenged is tantamount to a refusal by the

PTO to **examine** a single Markush claim in a single application because, in its opinion, it is **broad** enough to "embrace" or "cover" a plurality of inventions which, if presented separately, would be separately patentable, assuming any one of them to be prior art. The label it attaches to such broad claim is "improper Markush" and the situation is described as "misjoinder." The fault in the PTO position is that it overlooks the obvious fact that almost any reasonably broad claim "embraces" or "covers" a multiplicity of inventions, in the sense of "dominating" them, which inventions might be separately patentable if and when presented in separate applications. Logically, this is not sufficient excuse for refusing to examine a claim on its merits for compliance with 35 U.S.C. §101, §102, §103 and §112. *None of those statutory sections, of course, justifies a refusal to examine.* The only justification or statutory authority put forward for refusing to examine is 35 U.S.C. §121. There is nothing therein, however, to excuse a refusal to examine an elected invention or an applicant's generic (broad) claim reading thereon, notwithstanding the generic claim reads on nonelected inventions and possibly many others, all potentially separately patentable...." (Emphasis added)

So the discretionary power to limit one application to one invention is no excuse at all for refusing to examine a broad claim no matter how broad, which means no matter how many independently patentable inventions may fall within it.

Weber stands for the proposition that the Examiner improperly required a restriction requirement between subject matter within a claim. The Court held that a rejection under 35 U.S.C. §121 violates the basic right of the applicant to claim his invention as he chooses.

In the instant application, the Examiner required a restriction requirement between subject matter within a claim. Such a restriction requirement is tantamount to a rejection inasmuch as Applicants should be entitled to draft a claim as they see fit. Moreover, the Office Action overlooked the fact that all of the groups identified by the Examiner are used for the same utility, i.e., A modular system of combinable and adjustable design for inside closet use or as dressing room complements of different widths. The common property of the system comprises the tower modules and one or more hanging element.

The Markush group is proper if "unity of invention" exists as evidenced by a substantial structural feature of the claimed compounds, e.g., J is a heterocyclic substituent, which is disclosed as essential to at least one disclosed utility. *Ex parte Hozumi*, 3 USPQ 2d 1059 (POBA 1984).

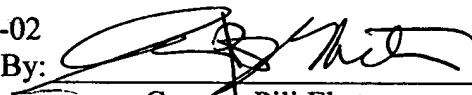
It is submitted that an examination of the tower module and one or more hanging element do not present a search burden on the Examiner. It is submitted that one or more hanging element may be on one side or other side of the tower module. Moreover, one or more hanging element may be on one side and other side of the tower module. Assuming *arguendo*, that different fields of search are involved does not establish that a Markush group is improper. It is the group of structures which are claimed, not the structural substituents thereof which are defined in Markush form which determines whether the claimed subject matter is so divergent as to be improperly associated in a single claim.

In view of the above, withdrawal of the election of species/restriction requirement is respectfully requested. It is respectfully submitted that the claims are in condition for examination. In the event that there are any problems which can be expedited by telephone conference, the Examiner is invited to telephone the Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,
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